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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,366	03/28/2005	Karsten Eulenberg	18744-0031	4786

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EXAMINER

CHOWDHURY, IQBAL HOSSAIN

ART UNIT	PAPER NUMBER
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1652

MAIL DATE	DELIVERY MODE
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05/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/529,366

Applicant(s)

EULENBERG ET AL.

Examiner

Iqbal H. Chowdhury, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____                                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____   | 6) <input type="checkbox"/> Other: ____                           |

### DETAILED ACTION

Claims 1-33 are pending.

#### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, Claims 1 (in part), and Claims 2-7, 10-15, 20-21, and 33, drawn to a nucleic acid molecule and recombinant host cell.

Group II, Claims 1 (in part), and Claim 8, 9, 33, drawn to a protein molecule.

Group III, Claim 1, 33, in part, drawn to a modulator of a nucleic acid molecule.

Group IV, Claim 1, 33, in part, drawn to a modulator of a protein molecule.

Group V, Claim 16, 28, 30, 31, in part, drawn to a method of making a medicament by using nucleic acid molecule.

Group VI, Claim 16, 29, in part, drawn to a method of making a medicament by using protein molecule.

Group VII, Claim 16, in part, drawn to a method of making a medicament by using modulator of nucleic acid molecule.

Group VIII, Claim 16, 27, in part, drawn to a method of making a medicament by using modulator of protein molecule.

Group IX, Claim 17, in part, drawn to a method of screening assays for modulators of nucleic acid molecule.

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Group X, Claim 17 and 24, in part, drawn to a method of screening assays for modulators of protein molecule.

Group XI, Claim 16, 27, in part, drawn to a method of making a medicament by using modulator of protein molecule.

Group XII, Claims 18-19, drawn to a non-human transgenic animal.

Group XIII, Claims 22, drawn to a method of identifying a binding partner of said polypeptides.

Group XIV, Claims 23, drawn to a method for identifying agent, which modulates the binding of polypeptide with binding target.

Group XV, Claims 24, drawn to a method for identifying agents, which modulates the activity of the polypeptide.

Group XVI, Claims 25-26, drawn to a method for making a pharmaceutical composition comprising a binding partner of the polypeptide of Group II.

Group XVII, Claims 32, drawn to a method for making a transgenic animal using nucleic acid molecule.

Group XVIII, Claims 33, drawn to a kit comprising an antibody.

Group XIX, Claims 33, drawn to a kit comprising an antisense oligonucleotide.

For each of Invention I-XVII above, restriction to one or more of the following is also required under 35 USC 121. Therefore, election is required of one of Inventions I-XVII and one or more of Inventions (A)-(HH), as indicated.

If Invention I, III, V, VII, IX, X, XV or XVIII is elected, elect one of:

(A.) Genes encoded by one of the cDNA set forth in Table I

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If Invention II, IV, VI, VIII, XI, XII, XIII, or XIV is elected, elect one of:

One of the proteins set forth in Table I

The inventions listed as Groups I-XIX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons. The technical feature linking Groups I-XIX appears to be that they all relate to proteins involved in the regulation of energy homeostasis. However, proteins involved in the regulation of energy homeostasis were known in the art. For example, Mayers et al. (2001) teach a dual specific phosphatase protein and uses thereof, which is known in the art. Thus, a DNA or protein and uses thereof, does not make contribution over the prior art.

Searching more than one of Groups I-XIX would represent a burden on the Office for the following reasons. Because the products of Groups I-IV, XII, XVIII and XIX, do not share a special structural and functional feature, a search for any one said product would not encompass a search for any other said products. Thus, a search for more than one of the products of Groups I-IV, XII, XVIII and XIX would be a burden on the Office. A search for any one of the methods of Groups V-XI and XIII-XVII would not encompass a search for any other said methods because the methods do not share a special technical feature of steps and products used, or results produced. Thus, the search for more than one of Groups V-XI and XIII-XVII would be a burden on the Office. A search of any one of the products of I-IV, XII, XVIII and XIX would not encompass a search of any of the methods of Groups V-XI and XIII-XVII, or vice versa, because said methods are not the only methods of making or using said products. Thus, a search of any one of the products of Groups I-IV, XII, XVIII and XIX with any of the methods of Groups V-XI and XIII-XVII would be a burden on the Office.

These inventions lack Unity of Invention for the reasons given above. Furthermore, each invention has acquired a separate status in the art due to their recognized divergent subject matter and, thus, searching more than one invention would be a burden on the Office. Therefore, restriction for examination purposes, as indicated, is proper.

37 CFR 1.475 does not provide for multiple products and/or methods within a single application. Therefore, inventions of Group I - XIX lack unity of invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102,

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103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Iqbal Chowdhury whose telephone number is 571-272-8137. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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